

REMARKS

INTRODUCTION:

As set forth in the preceding section, claims 1, 44 and 45 have been amended. Support for the amendment may be found at least at paragraph [0047] of the present application and therefore no new matter has been added.

Claims 1, 2, 3, 5-12, 44 and 45 are pending and under consideration. Claims 1, 44 and 45 are independent claims. Applicant requests reconsideration and allowance of the present application in view of the current amendments and the following remarks.

REJECTIONS UNDER 35 U.S.C. §101:

Claims 1-3, 5-12, and 44-45 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The rejections are traversed and reconsideration is requested.

Claims 1, 44, and 45 have been amended to address the rejection and to clarify the recitations. Accordingly, it is respectfully requested the rejection of claims 1-3, 5-12, and 44-45 be withdrawn.

REJECTIONS UNDER 35 U.S.C. §112:

Claims 1-3, 5-12, and 44-45 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The rejections are traversed and reconsideration is requested.

The independent claims have been amended to address the rejections and to clarify the recitations. Accordingly, it is respectfully requested these rejections be withdrawn.

DOUBLE PATENTING:

Claims 1-3, 5-12, and 44-45 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting in view of claim 17-26 and 29 of co-pending Application No. 11/980,642, as set forth in the Office Action at page 4, item 14. Since claims 1-3, 5-12, and 44-45 of the present application have not yet been allowed, it is believed that any submission of a Terminal Disclaimer or arguments as to the non-obvious nature of the claims would be premature. As such, Applicant respectfully requests permission to address any

obviousness-type double patenting issues remaining once the rejections of the claims under 35 U.S.C. §103 have been resolved.

REJECTIONS UNDER 35 USC §103:

Claims 1-2, 5-11, 44 and 45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5, 768,526 to Fawcett ("Fawcett") in view of U.S. Patent Publication No. 2002/0188614 by King et al. ("King"). Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Fawcett in view of King and further in view of U.S. Patent Publication No. 2003/0081791 by Erickson et al. ("Erickson"). Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fawcett in view of King and further in view of U.S. Patent No. 7,209,571 to Davis et al. ("Davis Patent"). Claims 8-10 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fawcett in view of King and further in view of U.S. Patent Publication No. 2002/0001395 by Davis et al. ("Davis Publication"). The rejections are respectfully traversed.

Amended independent claim 1 recites at least:

generating a plurality of metadata fragment data by partitioning metadata to be transmitted based upon a predetermined semantic unit

Applicant respectfully submits that the cited portions of Fawcett and King, alone or in combination, fail to suggest or disclose all of the above-claimed features.

The Office Action fails to specifically set forth if and where the above-claimed features are disclosed in Fawcett or King. If the above rejection is to be maintained, Applicant respectfully requests the Examiner provide a specific paragraph number and figure reference, or specifically indicate if an assertion of inherency is being relied upon. Further, any subsequent Office Action should be made non-final to give Applicant an opportunity to review the Office's position as to these arguments and to clarify the record for appeal.

Fawcett is directed to a method and apparatus for validating data packets in a paging system. The Office Action separately asserts that Fawcett describes "selecting a predetermined metadata fragment data from among the plurality of metadata fragment data," at col. 4, lines 26-32 where Fawcett describes extracting predetermined portions of the APDU. However, the Office Action fails to establish that the cited portions of the APDU from Fawcett are "metadata fragment data," or that the cited portions of the APDU are "generated ...by partitioning metadata

to be transmitted based upon a predetermined semantic unit." Accordingly, the Office Action fails to establish that Fawcett describes all of the above-recited features.

In addition, the Office Action fails to establish that King compensates for the noted deficiencies of Fawcett.

Amended independent claim 1 further recites at least:

transmitting a container including the selected metadata fragment data and the metadata-related information with a header including data format information indicating a data format type of the selected metadata fragment data.

Applicant respectfully submits that the cited portions of Fawcett and King, alone or in combination, fail to suggest or disclose all of the above-claimed features.

The Office Action notes at page 6, item 17, that "Fawcett does not disclose data format information indicating a type of the selected metadata fragment data resided in the container." However, the Office Action proposes, at page 7, to modify Fawcett based on King and asserts that King "discloses data format information indicating a type of the selected metadata fragment data resided in the container" at page 9 table 3 and paragraphs [0102] and [0127].

Applicant respectfully disagrees with the Office Action conclusion for at least the following reasons.

Applicant first notes that the Office's characterization of claim 1 is not an accurate quote with respect to the claim's literal recitations, either as recited now or prior to the current amendments.

King is directed to a method for storing multi-dimensional data in a database. More specifically, the cited portions of King refer to FIG. 28 and its corresponding text, which describe a phxFile 2800 implemented with a persistent storage methodology and having a file header phxFileHead 2802. Cited paragraph [0102] describes the file header 2802 as follows:

In the illustrative embodiment of the invention, file header 2802 contains a latch field 2902, a version field 2904, a frame size field 2906, a hash type field 2908, a modulo field 2910, and a Next frame field 2912, as illustrated in FIG. 29 and described in Table 3. 4.

However, the cited portions of King describe saving the data noted above contiguously as persistent storage (paragraph [0127]), but are completely silent with respect to "transmitting

a container," as claimed. In fact, a word search reveals that King fails to even mention the term "container."

Nevertheless, even assuming for the sake of argument that King does describe a "container," King still fails to describe all of the above-recited features of claim 1. For example, the Office Action appears to assert that fields 2902 – 2912 of King correspond to "metadata-related information," as claimed. Assuming for the sake of argument that this is accurate, the Office still fails to show where King describes "data format information indicating a data format type of the selected metadata fragment data," as recited in claim 1. Even if the Office relies on Fawcett to describe "transmitting the selected metadata fragment data," since the Office relies on King to illustrate a "container," as claimed, the Office **must** establish that the alleged container of King includes **each of** the items included in the container, as recited in claim 1. Absent such a showing, the Office fails to establish that the proposed combination describes all of the above-recited features.

Accordingly, Applicant respectfully submits that amended independent claim 1 patentably distinguishes over Fawcett, King and Davis, and should be allowable for at least the above-mentioned reasons.

Since similar features recited by each of the independent claims 44 and 45, with potentially differing scope and breadth, are not suggested or disclosed by the references, the rejection should be withdrawn and claims 44 and 45 also allowed.

Further, Applicants respectfully submit that claims 2, 3 and 5-12, which depend from independent claim 1, should be allowable for at least the same reasons as claim 1, as well as for the additional features recited therein.

Independent claim 44 recites at least:

transmitting a container including the selected metadata fragment data and the metadata digest information with a header including data format information indicating a type of the selected metadata fragment data.

Applicant respectfully submits that the cited portions of Fawcett and King, alone or in combination, fail to suggest or disclose all of the above-claimed features.

The Office Action notes at page 6, item 17, that "Fawcett does not disclose data format information indicating a type of the selected metadata fragment data resided in the container." However, the Office Action proposes, at page 7, to modify Fawcett based on King and asserts

that King "discloses data format information indicating a type of the selected metadata fragment data resided in the container" at page 9 table 3 and paragraphs [0102] and [0127].

Applicant respectfully disagrees with the Office Action conclusion for at least the following reasons.

Paragraph [0102] cited in the Office Action describes the file header 2802 as follows:

In the illustrative embodiment of the invention, file header 2802 contains a latch field 2902, a version field 2904, a frame size field 2906, a hash type field 2908, a modulo field 2910, and a Next frame field 2912, as illustrated in FIG. 29 and described in Table 3. 4.

As argued above with respect to claim 1, Applicant submits that the cited portions of King are completely silent with respect to "transmitting a container," as claimed. However, even assuming for the sake of argument that King describes a "container," King still fails to describe "a container including ... the metadata digest information," as recited in claim 44. For example, Applicant notes that the metadata digest information of claim 44 is generated "by substituting the selected metadata fragment data into a unidirectional function." In contrast, the hash type field 2908 of King merely identifies a particular "hashing algorithm corresponding to the hash type 2908," as described in paragraph [0129] of King. Applicant notes that a hash type field indicating a particular hashing algorithm is not the same as data obtained by substituting the selected metadata fragment data into a unidirectional function.

Accordingly, Applicant respectfully submits that independent claim 44 patentably distinguishes over Fawcett and King, and should be allowable for at least the above-mentioned reasons.

In addition, the Office fails to demonstrate that any of the other cited references compensate for the noted deficiencies of Fawcett and King.

Independent claim 45 further recites at least:

transmitting a metadata container-level authentication container including the selected metadata fragment data and the metadata container-level authentication message digest information with a header including data format information indicating a data format type of the selected metadata fragment data, wherein the data format information is used to determine whether the generated metadata digest information is valid.

Applicant respectfully submits that the Office fails to demonstrate that Fawcett and King, alone or in combination, suggest or disclose all of the above-recited features of claim 45.

Insufficient Reason to Combine Articulated

Applicant respectfully submits that the rejection fails to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness: 1) there must be some suggestion or reason to combine the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art; 2) there must be a reasonable expectation of success; and 3) the references must either teach or suggest all the claim limitations or the Office must provide a rationale as to why the differences between the claimed invention and the prior art are obvious. MPEP 2141.

Here, no persuasive citation to the prior art has been offered as providing a suggestion or reason to modify Fawcett and King, nor does the Office Action provide evidence demonstrating an implicit reason to modify the documents. In *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385, 127 SCt 1727 (2007), the U.S. Supreme Court held that in determining obviousness, it is necessary "to determine whether there was an apparent reason to combine the known elements in the fashion claimed" *KSR*, slip op. 14, 82 USPQ2d at 1396. Further, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR* at 1396, quoting *In re Kahn*. With respect to the rejection of claim 1, for example, the reasoning provided in the Office Action for combining Fawcett and King states:

Therefore it would have been obvious to a person skilled [sic] art at the time the invention was made to have included in Fawcett the feature of King as discussed above because there is [sic] a need exists for a database technology that allows any character or data type to be stored while still achieving optimal memory usage (King: paragraph 0018).

Applicant asserts that the cited rationale for combining Fawcett and King is merely a conclusion and therefore fails to meet the standard articulated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* In fact, the Office appears to have performed a search to find a random patent publication that allegedly describes "data format information," as claimed, without making any attempt to demonstrate that King is relevant to either Fawcett, or to the problems that the presently claimed invention seeks to overcome. For example, the Office Action states that the reason for combining King with Fawcett is that a need exists for a database technology that allows any character or data type to be stored. However, the Office fails to establish how such a database technology is even relevant to the disclosure of Fawcett, given that Fawcett is directed towards a method of validating communications between a transmitting component and a receiving component of a paging system.

As another example, King states that its objectives include avoiding the disadvantages of conventional database technologies and particularly relational and multivalue storage and retrieval methodologies (par. [0014]). According to King, these disadvantages, among others, include: 1) an orientation toward ASCII formatted data over other forms of data; and 2) the inability of either methodology to directly support the storage of graphics or audio data inside of a normal record (par. [0016]). The current rejection is deficient, however, because the Office fails to demonstrate how overcoming any of these disadvantages would be relevant to Fawcett.

In view of all of the above, Applicant respectfully asserts that the reason provided in the Office Action for combining King with Fawcett is merely a generalized conclusion and is therefore insufficient to meet the burden imposed by KSR. Absent a particularized reason, taking into account the problem that the presently claimed embodiment seeks to address, or a similarly relevant problem, the Examiner's rationale appears to be taken from Appellants' own application, and thus amounts to an improper hindsight reconstruction of the present invention.

Thus, the Office fails to demonstrate that one skilled in the art would have had a reason to combine the teachings of Fawcett with those of King, and the 103(a) rejection is improper.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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